

REMARKS

Status of the Claims

Claims 1-87 are pending in this application. No claim is amended by this Response.

Rejections Under 35 U.S.C. § 103

The Examiner has maintained three rejections under 35 U.S.C. § 103. First, claims 1-34 and 52-87 are rejected as obvious over U.S. Patent No. 6,312,477 to de la Mettrie et al. ("de la Mettrie"). Second, claims 35-44 are rejected as obvious over de la Mettrie in view of Publication No. WO 98/40471 to Sorenson et al. ("Sorenson"). And third, claims 45-51 are rejected over de la Mettrie in view of U.S. Patent No. 6,309,426 to Dias et al. ("Dias").

While the Applicant maintains that de la Mettrie does not teach or disclose 2,3-diamino-6-methoxypyridine in light of the fact that the patent erroneously incorporates that compound by reference, the Examiner alleges in the Advisory Action that de la Mettrie "teaches and discloses that 2,3-diamino-6-methoxypyridine . . . can be used as an oxidation base in the dye compositions even if such a compound has not been disclosed by the British patents" Applicant disagrees and respectfully requests withdrawal of these rejections for at least the reasons of record as well as the following reasons.

Whether the British patents incorporated by reference into de la Mettrie do teach the pyridine compound at issue or not, the Examiner has failed to establish a *prima facie* case of obviousness. As the Examiner knows, in order to establish a *prima facie* case, an Examiner must point to, among other things, a suggestion or motivation to

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modify the reference or to combine reference teachings. M.P.E.P. §2142. The Examiner must set forth "clear and particular" evidence of such motivation, *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999), and such a showing must be by "substantial evidence." *In re Zurko*, 258 F.3d 1378, 1384 (Fed. Cir. 2001). The Examiner has failed to meet this burden, and therefore Applicant respectfully requests reconsideration of this application.

The Examiner cites the following passage from de la Mettrie as teaching or suggesting the use of a 2,3-diaminopyridine:

Among the heterocyclic bases which can be used as oxidation bases in the dye composition . . . , mention may be made of pyridine derivatives Among the pyridine derivatives, mention may be made more particularly of the compounds described, for example, in patents GB 1,026,978 and GB 1,153,196, such as 2,5-diaminopyridine, 2,3-diamino-6-methoxypyridine, 2-(β -methoxyethyl)amino-5-amino-6-methoxypyridine and 3,4-diaminopyridine, and the additional salts thereof with an acid.

(de la Mettrie, col. 7, l. 64 - col. 8, l. 9.)

The Examiner believes that the disclosure of 2,3-diamino-6-methoxypyridine in this list of heterocyclic bases in de la Mettrie supports his argument for motivation. Applicant takes the position, however, that this disclosure in de la Mettrie would not have provided one of ordinary skill in the art with motivation to focus in on one compound, out of the numerous compounds mentioned or incorporated by reference. This passage in de la Mettrie does not "clearly and particularly" suggest modifying the reference by using the diaminopyridine compound. Instead, the compound is part of a list of possible compounds, and one of ordinary skill in the art would have no motivation to select the particular 2,3-diamino-6-methoxypyridine compound upon which the Examiner relies.

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Furthermore, the secondary references of Sorenson and Dias do not remedy this deficiency in de la Mettrie. Because, as argued on the record at length, neither of the secondary references nor de la Mettrie teach a pyridine compound falling within the presently claimed formula, it would be impossible for de la Mettrie in combination with *either* reference to teach all of the elements of the present invention, as required by M.P.E.P. §2142. Thus, Applicant respectfully requests the withdrawal of the obviousness rejections over de la Mettrie in view of Sorenson and Dias.

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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